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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,604	01/25/2001	Stephen M. Howard	EMC-002PUS	4397
51576 7590 07/17/2008 EMC CORPORATION c/o DALY, CROWLEY, MOFFORD & DURKEE, LLP 354ATURNPIKE STREET SUITE 301A CANTON, MA 02021-2714				
EXAMINER OSMAN, RAMY M				
ART UNIT 2157		PAPER NUMBER		
MAIL DATE 07/17/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/769,604

Applicant(s)

HOWARD ET AL.

Examiner

RAMY M. OSMAN

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This communication is in response to amendment filed on April 14, 2008, where applicant amended claim 22. Claims 1-15,17-22 are pending. What follows is a Non-Final Office Action.

Response to Amendment

2. Applicant's arguments filed 4/18/2008 have been fully considered but as a whole they are not persuasive.
3. The Declaration filed on April 18, 2008 under 37 CFR 1.131 continues to be deemed ineffective to overcome the Davis reference (US Patent Application No 6,594,677).
4. Applicants argue that they are attempting to establish "actual reduction to practice".

In reply, Applicant has not fully demonstrated with sufficient evidence that the Declaration satisfies all of the requirements as outlined below. (See Response to Declaration below)

Response to Declaration Under 37 CFR 1.131

REDUCTION TO PRACTICE

5. Applicant is attempting to establish actual reduction to practice of the claimed invention prior to December 22, 2000.

MPEP states:

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be

comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). (see **MPEP 715.07**)

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. (see **MPEP 715.07, section I**)

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”). (see **MPEP 715.07, section III**)

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. (see **MPEP 715.07, section III**)

6. In order to demonstrate actual reduction to practice, Applicant is required to show that the invention actually existed and worked for its intended purpose (see MPEP 715.07). Applicant is required to show that the invention existed in a physical or tangible form that shows every element of the invention (see MPEP 2138.05 section II). Benchmark or laboratory testing may be further required to show that the invention worked for its intended purpose (see MPEP 2138.05 section III).

Applicants must give a clear explanation of the exhibits pointing out exactly what facts are established by what exhibit, and what facts are relied upon by applicant. General statements and assertions by the Applicant that the exhibits describe a reduction to practice “amounts to mere pleading, unsupported by proof or a showing of facts” (see MPEP 715.07 section I).

Applicants must demonstrate sufficient evidence to show that the invention existed in a physical or tangible form that shows every element of the claimed invention.

7. Applicants have submitted exhibits A through C as purportedly demonstrating every element of the claimed invention. Claim 1 was mentioned as an example claim whose subject matter is functionally contained in software modules of Exhibit C.

Although the Exhibits appear to show most limitations of claim 1, every element of claim 1 is not apparent from the Exhibits. Particular limitations such as “submitting a second list of marked restorable objects to the backup storage system” and also “executing... such that first and second restore submissions can be made prior to restore execution”, are deemed to be lacking in the Exhibits.

8. The Declaration lacks a detailed mapping of limitations (such as the above mentioned limitations) explaining how the limitations correspond to the exhibits and evidences provided.

Exhibit A shows a software reference manual of the “EMC Data Manager” software. There is no demonstration as to the portions of this manual that relate to the above mentioned limitations.

Exhibit B shows software release notes for the “EMC Data Manager” software. There is no demonstration as to which of the software features mentioned in the notes relate to the above mentioned limitations.

Exhibit C (which contains exhibits C1 through C16) shows actual source code, with comments, which is used to purportedly perform functionality of the claims. There is no explanation as to which part(s) of the source code performs the above mentioned limitations.

Reduction to practice has not been shown because there is insufficient evidence that the Exhibits actually perform each and every claim limitation of the instant application.

9. Furthermore, Applicants have failed to provide evidence to show that the software actually worked for its intended purpose.

In order to show reduction to practice the device must have been sufficiently tested to prove it actually worked for its intended purpose. Applicant's submission is not adequate for the Examiner to be able to draw the conclusion that such testing took place. For Example, there is no information in the Exhibits that would allow for the examiner to determine whether the software was tested, whether test conditions represented actual working conditions (or at least were sufficiently close to actual conditions so that one would be confident that it would work in appropriate circumstances), or whether the tests were successful. For example, since no input/output scenarios are presented, the Examiner cannot determine anything about testing.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. See MPEP 715.07

For substantiating an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. (See MPEP 2138.05)

10. Each of the claim limitations found in the instant application have not been shown or explained in light of the exhibits so as to provide enough evidence of reduction to practice.

Thus, applicant has not met the burden of showing how the exhibit supports reduction to practice of the claimed invention and has not established that reduction to practice occurred prior to the date of the Davis reference.

DILIGENCE

11. Since Applicant has not demonstrated an actual reduction to practice, then Applicant may attempt to antedate the Davis reference by demonstrating conception of the invention prior to the date of the reference coupled with due diligence from prior to the reference date until the filing date of the instant application. Applicant would be required to demonstrate reasonable diligence during the critical period which begins prior to the date of the reference and ends with either the filing of the US application or with a demonstrated actual reduction to practice (see MPEP 715.07 (a)). The entire critical period must be accounted for by either affirmative acts or acceptable excuses.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-15,17-22 rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al (US Patent No 6,594,677).

14. For listing of claim rejections under 102(e), see Office Action dated October 17 2007.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ramy M Osman/
Primary Examiner, Art Unit 2157
July 15, 2008